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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/606,253

06/25/2003

Martin Crisp

200-007048-US(C02)

4490

7590

10/05/2004

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EXAMINER

VUONG, QUOCHIE B

ART UNIT

PAPER NUMBER

2685

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/606,253

Applicant(s)

CRISP, MARTIN

Examiner

Quochien B Vuong

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2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 06/25/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Priority*

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 08/804,388, filed on 03/21/1997.

### *Information Disclosure Statement*

2. The information disclosure statement (IDS) submitted on 06/25/03 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### *Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No.

6,151,485. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-23 of U.S. Patent No. 6,151,485 encompass all the limitations of claims 1-10 of the present application.

5. Claims 1-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No.

6,282,436. Although the conflicting claims are not identical, they are not patentably distinct from each other because 1-11 of U.S. Patent No. 6,282,436 encompass all the limitations of claims 1-10 of the present application.

6. Claims 1-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No.

6,647,249. Although the conflicting claims are not identical, they are not patentably distinct from each other because 1-14 of U.S. Patent No. 6,647,249 encompass all the limitations of claims 1-10 of the present application.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-2 and 4-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Martensson (US 5,151,946).

Regarding claim 1, Martensson discloses radio handset (figures 1-2) comprising a housing (1) having a key pad (3 and 4) including a plurality of keys mounted on a main body (2) and an extending portion (7) mounted for longitudinal slidable movement between a first position (figure 2) in which the plurality of keys are concealed and a second position (figure 1) in which the plurality of keys are exposed, and a processor operable to perform respective predetermined functions responsive to respective sequences of actuations of the keys, the processor means being operable to perform the predetermined functions corresponding to the respective sequences of actuations of exposed ones of the keys (4) for a range of positions of the extending portion (column 1, line 65 – column 2, line 59; column 3, lines 41-65).

Regarding claim 2, Martensson discloses the radio handset further comprising an additional key exposed (4) when the extending portion is in the first position (column 3, line 58-65).

Regarding claim 4, Martensson discloses if an incoming call is indicated, actuation of an exposed key places the handset in the off-hook condition (column 2, lines 47-53).

Regarding claim 5, Martensson discloses the processor means is operable to perform the predetermined functions corresponding to sequences of actuations of the exposed ones of the keys for each position of the extending portion (column 3, lines 58-65).

Regarding claim 6, Martensson discloses the extending portion can occupy any position intermediate the first and second positions (column 3, lines 52-64) (since the

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extending portion is slidable between the first position and second positions, therefore, it can occupy any position intermediate the first and second positions)

Regarding claim 7, Martensson discloses the main body comprises a first transducer and the extending portion comprises a second transducer, the first and second transducers being operational when the extending portion is in the first and second positions and positions intermediate the first and second positions (column 1, line 65 – column 2, line 8; column 4, lines 50-54).

Regarding claim 8, Martensson discloses wherein movement of the extending portion from the first position causes a call to be answered (column 4, line 60 – column 5, line 19).

Regarding claim 9, Martensson discloses wherein movement of the extending portion to the first position causes a call to be terminated (column 4, line 60 – column 5, line 19).

Regarding claim 10, Martensson discloses a radio handset (figures 1-2) comprising a housing (1) having a key pad (3) including a plurality of keys mounted on a main body (2) and an extending portion (7) mounted for longitudinal slidable movement between a first position (figure 2) in which the plurality of keys are concealed and a second position (figure 1) in which the plurality of keys are exposed, and processing means operable to place the handset in an off-hook condition with the extending portion in the first position, the second position and at least one intermediate position (column 4, line 60 – column 5, line 19).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martensson.

Regarding claim 3, Martensson discloses the radio handset of claim 2 above; in addition, Martensson discloses wherein the additional keys further being operable to control various functions such as memory storage, last number redial, call start, etc. (column 3, lines 41-47). Martensson does not address the output volume control. However, it is just an obvious basic function, a well known feature on almost every telephone handset. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to adapt the output volume control function into one of the control keys of Martensson in order to control the volume for the convenience of the user.

***Conclusion***

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quochien B Vuong whose telephone number is (703) 306-4530. The examiner can normally be reached on M-F 9:30-18:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached on (703) 305-4385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Quochien B. Vuong  
Sep. 30, 2004.